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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,601	06/26/2000	James D. Marks	30421/1G691-US2	3416

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Cheryl F Cohen
Darby & Darby PC
805 Third Avenue
New York, NY 10022

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,601

Applicant(s)MARKS, JAMES D. **Examiner**

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14,23-40,51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14,23-40,51 and 52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Response to Restriction Requirement: In response to the restriction requirement of March 19, 2004, applicant has elected the claims of group I, claims 1-14 and 28-34. Applicant has also amended the claims and now asserts that claims 1-40, 51 and 52 are associated with group I and therefore requests examination of these claims along with group I. Examiner finds that of claims 1-40 and 51-52, claims 15-22 are still addressed to non-elected group II, calling for a method or reviewing treatment for a medical program. Accordingly, claims 15-22 remain as part of the non-elected group. Claims 1-14, 23-40 and 51-52 will be examined on the merits. The restriction is made final.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 29-40 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (U.S. Patent 6,039,688) and Liles et al. (U.S. Patent 5,880, 731).

Claim 1: FIG. 14 illustrates an on-line forum available on a network site (col. 8, lines 1-5). The forum includes an expert (chairperson) and users (the remaining participants). The forum discusses a topic, typically related to a multi-media presentation (col. 12, lines 45-46 and lines 63-67). Payments are made by a third party to provide customers of the third party access to the site (see FIG. 54 which shows the payment costs for using the site under "Heartland Costs" and col. 19, lines 40-44 shows that a health plan incurs the cost).

Douglas et al. differs in that it does not specifically show the participants exchanging questions and answers. However, the reference to Liles et al. illustrates an analogous Avatar

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based discussion forum. As taught in col. 1, lines 23-25 and lines 39-45, the participants may exchange questions and answers with an expert.

It would have been obvious to one of ordinary skill in the art to modify Douglas et al. to have the participants exchange questions and answers with an expert in order to facilitate the learning by the participants as taught by Liles et al.

Claim 2: In Douglas et al., the payments (illustrated in FIG. 54 as “Heartland Costs” are paid to use and access the network sites.

Claim 3: No patentable weight is attributable to the nature of the third party, since the nature of the third party does not affect the actual method steps being performed. Nonetheless, in Douglas et al., the third party is a health plan (col. 19, lines 38-43), which is an insurance provider.

Claim 4: In Douglas et al., the third party makes payment of the fees to access the system. Once the access is provided, personal information about the users are then collected by the system (see FIGS 3-7).

Claim 5: In FIGS. 4 and 5 of Douglas et al., the personal information includes identification information, such as the user’s name.

Claim 6: Strictly speaking, a user will not provide identification information to a health plan payor (the third party) until they agree to subscribe to the health plan.

Claim 7: See remarks for claim 1. In Douglas et al., the expert is the chairperson. Any of the other participants may be considered “peer review personnel”.

Claim 8: See remarks for claim 1. In Douglas et al., one “benefit” may be access to the forum of FIG. 14.

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Claim 9: In Douglas et al., one benefit may be access to the forum.

Claim 10: In Douglas et al., col. 14, lines 38-52, the user may receive points for participating in the system. The points take the form of gold stars.

Claim 11: In Douglas et al., the points can be exchanged for other benefits, such as products at the village store.

Claim 12: See remarks for claim 1. The benefit may be access to the site or gold star points. The “another party” may simply be another user, such as other users that have participated in past forums.

Claim 13: The nature of the third party as a manufacturer, HMO or pharmacy carries no patentable weight since it has no bearing on the actual method steps being performed.

Claim 29: See remarks for claim 1. In Douglas et al., FIGS. 14-15 illustrate two different network sites within the system. The two sites do not have the same expert (chairperson) in common.

Claim 30: In Douglas et al., FIG. 14 illustrates one network site having a chairperson as the expert. Other forums like that of FIG. 14 but on other topics constitute other network sites and will also include a chairperson.

Claims 31: The common expert is the chairperson. The common expert may be said to be applying materials selected by the third party in the sense that the third party (Health Plan Payor) actually selects the usage of the Heartland system. The common expert may also be considered “peer review personnel” since this is only a title rather than a description of the functions that the expert performs.

Claim 32: See remarks for claim 31. The common expert may be said to select material independently of the third party (health plan payor) in the sense that the expert selects presentations based on the known problems and needs of the users (col. 11, lines 54-58).

Claim 33: The job title or nature of the common expert carries no patentable weight since it does not affect the actual method steps being performed.

Claim 34: See remarks for claim 13.

Claim 35: See remarks for claim 1.

Claim 36: In Douglas et al. FIG. 14, responses are posted on the site in which they originate.

Claim 37: In Douglas et al. FIGS. 14-15, responses may be posted both on the site of FIG. 14 and also applied to a different site, such as that of FIG. 15.

Claim 38: In Douglas et al., the peer review personnel may be any of the other participants besides the chairperson. Responses from the participants may be posted on either of the sites of FIGS. 14 or 15.

Claim 39: In Douglas et al., the chairperson's responses only appear on the site of FIG. 14.

Claim 40: The peer review personnel may be the other participants besides the chairperson. The responses from these participants may be posted on either of the sites shown in FIGS. 14 or 15.

Claim 51: See remarks for claim 2.

Claim 52: The third party is a health plan payor and provides services related to the field of health, just as the system of Douglas et al. provides services related to the field of health.

Claims 14 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (U.S. Patent 6,039,688) in view of Liles et al. (U.S. Patent 5,880,731) and further in view of Christensen (US2003/088461).

Claims 14 and 23: Douglas et al. and Liles et al. differ from these claims in that they do not illustrate the points earned by the participant in the forum as being used for discounts on drugs. However, Christensen teaches that a user participating in an on-line website can receive coupons leading to discounts on specific grocery items, including health and beauty items (FIG. 6) which would include medical treatments or drugs. It would have been obvious to one of ordinary skill in the art to modify Douglas et al. and Liles et al. to further permit the user to exchange the earned gold points for discount coupons so as to give the user a wider choice of available rewards (rather than limiting the user to rewards in a village store) as taught by Christensen.

Claims 24-27: The expert is the chairperson and may inherently express multiple opinions or provide multiple types of information to the participants in the forum. The peers may be other participants in the forum.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (U.S. Patent 6,039,688) in view of Liles et al. (U.S. Patent 5,880,731) and further in view of Rice et al. (U.S. Patent 6,658,467).

Claim 28: See remarks for claim 1. Douglas et al. and Liles et al. differ in that they do not disclose banner ads. Rice et al. (col. 6, lines 35-52) teach that Banner ads may be applied to network websites. The advertisers receives fees based on users using the banner ad to reach the website and purchase products. The more users that access the advertiser's site and make

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purchases, the greater the fees obtained by the advertiser. The website supporting the ad also receives revenue for displaying the ad. A larger number of ads inherently produces a larger amount of revenue for the website operator. It would have been obvious to one of ordinary skill in the art to modify the network of Douglas et al. to include banner ads so as to permit the website sponsor to generate additional revenue as taught by Rice et al.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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